

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DN 96-006 D1
MJP/MJH

In re application of:

Donald K. Drummond :

Application No.: 09/826,062 : Group No.: 1731

Filed: 04/04/2001 : Examiner: Peter Chin

For: THE USE OF CALCIUM CARBONATE IN AN ACIDIC AQUEOUS MEDIA

Assistant Commissioner for Patents
Washington, DC 20231

7/KJ
12/21/02

Reconsideration of Restriction Requirement Under 37 CFR §1.143

Sir:

This is in response to the Notice of Restriction dated November 20, 2002. Examiner requested Applicant elect Claims 1, 17-20 or Claims 22-24 for examination in the current application.

REMARKS

Claims 1-24 were originally filed. Claims 2-16 were withdrawn from consideration. Claims 1 and 17 - 24 are pending in the current application. Examiner issued a restriction to one of the following inventions under 35 U.S.C 121:

- I. Claims 1, 17-20, drawn to a calcium carbonate slurry, classified in class 106, subclass 461.
- II. Claims 22-24, drawn to a method of making paper, classified in class 162, subclass 181.2.

FAX RECEIVED
DEC 18 2002
GROUP 1700

Restriction of Invention

Group I is provisionally elected with traverse for further prosecution on the merits.

Reconsideration of the Restriction Requirement is restricted for the following reasons:

Applicant contends the restriction requirement as submitted is improper. Examiner states that Claims 22-24 are drawn to a method of making paper. Examiner is mistaken, Claims 22-24 are drawn to an "acid-stabilized calcium carbonate slurry having a pH of less than 7".

Group I claims relate to an acid-stabilized calcium carbonate slurry while the Group II claims relate to a method of making the acid-stabilized slurry. However, Claim 21 is drawn to a method of making paper. Examiner is silent with respect to restriction of Claim 21 and Applicant would like to request if Examiner could clarify if, in fact, he meant to restrict Claim 21.

Therefore, Applicant contends that Claims 1, 17-20 and 22-24 are not independent or distinct.

Examiner also states that Applicants' "product can be used in a materially different process such as coating plywood or a brick wall."

Applicant teaches a calcium carbonate slurry comprising: (1) water, (2) calcium carbonate and (3) an acid-stabilizer. Calcium carbonate can be one component in coatings for plywood or brickwalls, but only in combination with binders, resins, conditioning agents and this would be under alkaline conditions. Applicants' invention would not in and of itself be used in coating applications of plywood or brickwalls.

Additionally, Applicant discloses in the preamble of Claim 1 that the product is used in making acid paper linking the acid-stabilized calcium carbonate slurry with the process of producing and acid paper.

Restriction of Species

Examiner is requiring Applicant to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable and that currently, Claims 1, 17, 18 and 21-24 are generic. In particular, Examiner is requesting restriction of the acid stabilizer to a (I) water soluble calcium salt, (II) weak acid, (III) chelating agent or a (IV) mixture of water soluble calcium salt and chelating agent. Examiner also stated if Group (I) or (IV) is elected, Applicant must elect a single species of weak acid.

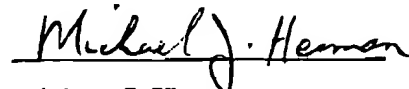
The acid stabilizers from Group II are provisionally elected with traverse, to be prosecuted on the merits. Wherein, the weak acids of Group II include those recited in Claim 19.

CONCLUSION

Should the Examiner not agree with the Applicants' position, then a personal interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No fee is believed due for the filing of this response. Should any fees be required, however, please charge such fees to Minerals technologies Inc. Deposit Account No. 13-3639.

Respectfully submitted,



Michael J. Herman

Registration No. 51,289

Agent for Applicant